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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT	PAPER NUMBER
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1624

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ELECTRONIC

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ADVISORY ACTION

The applicants' response, which included amendment to claims 9 and 10, filed 4/8/2008 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance for the following reasons. In view of applicants' amendment, all 112 second paragraph rejections and claim objection made in the previous officer action have been obviated.

However, the following 103 rejection over Tanimoto et al., made in the previous office action is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimoto et al., US 6,562,817 for reasons of record. To repeat:

Tanimoto et al., teaches several tricyclic compounds for use in organ transplant, which include instant compounds. See column 1, formula I and note the definition of various variable groups A, B C, X-Y V1 and V2. Also see column 13, formula If and column 14 for B ring definition, which include pyrimidine. Note with the given definition of various variable groups, the compounds taught by Tanimoto et al. include instant compounds. Specifically, in formula I, B ring is pyrimidine, C ring a heterocycle, A ring is phenyl, X –Y is O-alkyl, O-alkenyloxy and others, the compounds taught by Tanimoto et al., include instant compounds. See entire document. Especially see column 109 for various A ring definitions and note X-Y can be allyloxy group. See also column 115 and note B ring choice S3 is a pyrimidinyl group as required by instant claims. Also note S1 is pyridinyl group. See column 150-151, Table 86 for pyridine and pyrimidine compounds.

Tanimoto et al. differs from the instant claims in exemplifying pyrimidine compounds having O-benzyl group for X-Y and other groups hydroxy, sulfonyl etc as

substituents for in the phenyl ring. However, Tanimoto et al. when B=S1, namely pyridine ring, teaches allyloxy group for X-Y.

In addition, Tanimoto teaches equivalency of those compounds taught in Table 86 those generically recited in column 1-14.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compositions using the teachings of Tanimoto et al., including phenyl ring bearing substituents corresponding to instant compounds and expect resulting composition to possess the uses taught by the art in view of the equivalency teaching outline above.

This rejection is same as made in the previous office action.

Applicants' argument to overcome this rejection is not persuasive.

Applicants argued that the use of compounds as pharmaceuticals taught by Tanimoto is different from instant fungicidal use. But a compound is a compound and use of the compound for different purposes does alter its structural make-up. In addition the rejection is applied to only compound claims not to method of use claims. One trained in the art would be motivated to make the compounds of Tanimoto for the use taught therein. Tanimoto as noted above teaches a genus of compounds, exemplifies large number compounds including those with allyloxy substituents, and thereby provides guidance for choosing substituents. Thus, there is motivation to make the compounds of the genus as one would expect the genus would share the same use as those exemplified compounds. Hence, teaching suggestion and motivation requirements are clearly met with. Hence, In re Vaeck cited by the applicants is not the

point. In *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), the court stated that

[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

Such is the case with Tanimoto. Teaching and suggestion variable groups and those exemplified compounds would lead one of ordinary skill to make the said compounds for the use taught therein. Again, it is not *In re Baird* situation as the core compound is taught with only variation in substitution and that there is adequate guidance provided by Tanimoto to have allyloxy group for X-Y. In this regard applicants should note *In re Bruckel*, 201 USPQ 67., “References must be considered under 35 U.S.C 103, not only for what it expressly teaches but also for what it fairly suggests; all disclosures of prior art, including unpreferred embodiments must be considered in determining obviousness”.

As noted above, based on the generic teachings and the equivalency teaching of the exemplified compounds with those generically claimed, one trained in the art would be motivated to make compounds of the genus of Tanimoto et al., and expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above. Hence, this rejection is proper and is maintained.

Response to Applicants' traversal dated 4/8/2008:

Again, this rejection is same as made in the previous office action and for reasons discussed above, this rejection is proper.

As for applicants' argument that Tanimoto' genus is large and include several hundred choices, it does not matter how large the prior art genus is as long as there is guidance to make the compounds of the genus. Tanimoto clearly exemplifies large number of compounds as representative examples of the genus embraced. See column 58-152, Table 1-Table 87. As pointed out above, Table 86 include pyrimidine compounds and Tanimoto clearly teaches allyloxy as substituents on phenyl and exemplifies several compounds with such a substituents.

Hence, as noted above, In KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727 (2007), the court stated that

[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

Such is the case with instant claims. Teaching of Tanimoto and suggestion of Tanimoto including compounds with various variable groups and those exemplified compounds would lead one of ordinary skill to make the said compounds for the use taught therein. As pointed out by the court, it is likely the product not of innovation but of ordinary skill and common sense.

Hence, this rejection is proper and is maintained.

Allowable Subject Matter

Claims 9 and 10 are allowed.

Conclusion

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

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/Venkataraman Balasubramanian/

Primary Examiner, Art Unit 1624

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